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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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27433	7590	05/23/2006		
FOLEY & LARDNER LLP 321 NORTH CLARK STREET SUITE 2800 CHICAGO, IL 60610-4764			EXAMINER ABEL JALIL, NEVEEN	
			ART UNIT 2165	PAPER NUMBER

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,359

Applicant(s)

MOSTAFA, MIRAJ

Examiner

Neveen Abel-Jalil

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2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Remarks

1. The Amendment filed on 20-March-2006 has been received and entered. Claims 17 and 18 have been cancelled. Claims 19-22 are newly added. Therefore, claims 1-16, and 19-22 are now pending.
2. Applicant's amendment has overcome the 112, first paragraph, and 112, second paragraph previously presented.
3. The Double Patenting rejection is hereby withdrawn.

Claim Objections

4. Claims 2-10, 14-16, and 9-22 are objected to because of the following informalities: All the dependent claims start with the article "A" indicating a new instance of the method, network entity communication system, and apparatus. Dependent claims should start with "The" referring back the claims on which they dependent. Appropriate correction is required.

Claim 16, line 2 recite the article "the" twice consecutively which is a type that requires correction.

Claim 6, line 6, recite the optional "if" making the limitaion following not having to take place therefore not having patentable weight in the instant it does not exist. Claim should be

amended to recite more definite direct language such as “wherein” or “when”. Correction is required.

Claim 3, line 2, recite the intended use recitation of “in order to” making the limitation following not carry any patentable weight. Correction is required.

Claim 6, line 4, recite the intended use recitation of “using the recipient data” describes only intended use but not necessarily required functionality of the claim which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form such as “by recipient the data”.

Claim 10, line 3, recite “a first telecommunication network” although introduced previously in claim 9 of which 10 depends. It is unclear to the Examiner if this recitation represents a new instance of the telecommunication network or its referring back to the original mention therefore lacks antecedent basis. Correction is required.

Claim 15 contains multiple instances of “the network” in lines 4-5 making unclear to which one of the first or second network those listed properties refer to and also making it unclear what “that network” is also referencing. Correction/clarification is required.

Claim 15, line 5, recites “the availability of processing resources” which lacks antecedent basis. Correction is required.

Claims 10, and 15 are improper dependent claims since they recite language that was made optional in claim 9 of which both depend.

Claims 10, and 15 are objected to under 37 CFR 1.75(c) , as being of improper dependent form for failing to further limit the subject matter of the previous claim. Applicant is required to cancel the claim (s), or amend the claim(s) to place the claim (s) in proper dependent form, or rewrite the claim (s).

Claim 9, recite the conditional “is chosen from the group consisting of...a first telecommunication network, a second telecommunication network....”, which in the case where there is match to a “a second telecommunication” would omit the remaining options of the claim therefore making claims 10, and 15 failing to further limit the subject matter. “A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be constructed to incorporate by reference all the limitations of the claim to which it refers” (See 35 U.S.C. 112 fourth paragraph).

Applicant’s recitation of “for transmission” in claims 1, and 11-13 constitute intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably, therefore carry no patentable weight.

Claims 1, and 11-13 are indefinite because the phrase “and/or” renders the claim indefinite since its unclear why the applicant is making a distinction if the intention is all along to include both instances of the limitaion or its alternative.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7, 9-16, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Luzeski et al. (U.S. Patent No. 6,430,177 B1).

As to claims 1, 11, 12, and 13, Luzeski et al. discloses a method in a network entity, a computer program for controlling a network entity stored therein, the program when executed causing the network to perform, a communication system, comprising:

at least one recipient (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16);

a network entity (abstract);

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receiving media content from a sending entity and addressed to at least one recipient (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16);

accessing a database comprising recipient data describing multimedia reception capabilities and/or reception preferences for at least one recipient (See column 13, lines 18-33, also see column 14, lines 6-12);

forming, in accordance with said recipient data, a notification message (lines 7-29 of column 20) containing information that said media content is available to be streamed to said at least one addressed recipient (lines 49-54 of column 20, line 66 of column 20 through line 12 of column 21, and Fig. 4D); and

outputting the notification message (lines 49-54 of column 20, line 66 of column 20 through line 12 of column 21, and Fig. 4D) for transmission to said at least one addressed recipient (The recitation of “for” accomplishing a function is intended use, indirect, and passive which renders any recitation claimed after not be given patentable weight).

As to claim 2, Luzeski et al. discloses further comprising the steps of:

receiving the media content in a multimedia messaging server (abstract and lines 23-34 of column 2); and

providing the at least one addressed recipient with the media content via the network entity (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16);

wherein the network entity is a multimedia messaging relay (lines 22-34 of column 2 and lines 25-45 of column 4).

As to claim 3, Luzeski et al. discloses wherein a streaming session is established (lines 30-48 of column 20, lines 55-65 of column 20, and Fig. 4D) in order to stream at least some of the media content to said at least one recipient (The recitation of “in order to” accomplishing a function is intended use, indirect, and passive which renders any recitation claimed after not be given patentable weight).

As to claim 4, Luzeski et al. discloses wherein said establishing of a streamed session is preceded by transmitting the notification message to said at least one addressed recipient (lines 30-48 of column 20, lines 55-65 of column 20, and Fig. 4D, also lines 27-32 of column 12).

As to claim 5, Luzeski et al. discloses wherein the media content comprises a set of different types of components and each component can be formatted in one or more formats (See column 2, lines 4-34, prior art).

As to claim 6, Luzeski et al. discloses wherein the method further comprises the following steps before said outputting of the media content:

checking the format of at least one component of the received media content (See column 2, lines 4-34, prior art);

determining by using the recipient data whether the format is appropriate for said at least one addressed recipient (See column 4, lines 45-54, also see column 12, lines 5-15, also see column 14, lines 41-65); and

if necessary, translating the component into a format appropriate for said at least one addressed recipient (See column 4, lines 45-54, also see column 12, lines 5-15, also see column 14, lines 41-65).

As to claim 7, Luzeski et al. discloses wherein said notification message provides a minimum amount of information necessary for said at least one addressed recipient to establish a streaming session with the said network entity (See column 18, lines 15-42, also see column 17, lines 1-18).

As to claim 9, Luzeski et al. discloses wherein said sending entity is **chosen from a group** consisting of:

a media storing entity of a first telecommunication network, a media storing entity of a second telecommunication network, a media storage in an external data transmission network, and a terminal of the first telecommunication network (lines 51-54 of column 3, lines 29-45 of column 5 and item 10-2 of Fig. 1 --notification server--, lines 46-62 of column 5 and items 12-4 and 12-5, both of Fig. 1 --content server--; items are shown as separate units --messaging platform 10-- and --server (web platform) 12-- in Fig. 1).

As to claim 10, Luzeski et al. discloses wherein the first telecommunication network possesses given properties, and wherein the method further comprises transmitting the notification message to said at least one addressed recipient via a first telecommunication network and forming said notification message taking into account the properties of the first telecommunication network (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16).

As to claim 14, Luzeski et al. discloses wherein the media content comprises a set of different types of components and each component can be formatted in one or more formats (See column 2, lines 4-34, prior art, also see column 13, lines 18-25).

As to claim 15, Luzeski et al. discloses wherein the first telecommunication network posses multimedia capabilities (See column 5, lines 46-55, also see column 6, lines 22-32) , traffic condition (inherit in the network part of reducing overhead column 3, lines 1-9), and processing resources (See column 4, lines 46-50, wherein “processing resources” reads on “viewable by custom clients”), and wherein said properties of the first telecommunications network contain **at least one** or more of the following:

the network’s multimedia capabilities (See column 18, lines 15-42), the network’s traffic condition, and the availability of processing resources in that network (See column 13, lines 49-57).

As to claim 16, Luzeski et al. discloses wherein the receiving of the media content from a sending entity includes forwarding the media content, via said network entity to a multimedia messaging server corresponding to a communication system of said network entity (lines 22-34 of column 2 and lines 25-45 of column 4).

As to claims 19-22, Luzeski et al. discloses wherein the forming of the notification message and the outputting of the notification message are performed locally within a multimedia environment (The recitation of environment is broad enough to encompass many and all things (server, client, or database) thus column 4, lines 40-50 of Luzeski et al. teaches message portion header for presentation and body with content for targeted delivery all in one message).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luzeski et al. (U.S. Patent No. 6,430,177 B1) in view of Ehrlich et al. (U.S. Patent No. 6,546,427 B1).

Luzeski et al. does not each wherein the network entity communicates with the at least one addressed recipient over a radio communication network.

Ehrlich et al. teaches wherein the network entity communicates with the at least one addressed recipient over a radio communication network (See Ehrlich et al. Figure 1, 12, radio station, 16, Internet, wherein the user is accessing radio services through the Internet, also see Ehrlich et al. column 3, lines 18-31).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to communication with at least one addressed recipient over a radio communication network because it constitute one example of various modes of communication networks currently available in the art and provides for better access to resources around the globe (See Ehrlich et al. column 1, lines 52-57).

Response to Arguments

9. Applicant's arguments filed 20-March-2006 have been fully considered but they are not persuasive.

Applicant's response contains multiple arguments directed to features only recited in the specification (examples in the response to that effect too) and not claimed.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., server accounts for preferences and capabilities of the recipient, or the server's behavior can be modified to account to a recipient's preferences or capabilities, or each addressed recipient may have different capabilities and the steaming session maybe established at different times and

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media content streamed in different formats) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, what is claimed is a “database” that stored the recipient data describing capabilities and/or reception preferences and NOT a server to that effect. “A database” is taught in Luzeski et al. column 13, lines 9-22, wherein content manager manages and stores lists/formats and column 4, lines 15-24 “storing customer messaging clients and user profile/subscription” (i.e. capabilities and preferences).

The only recitation of a “server” made in the claims is found in dependent claims 2, and 16 and is directed to receiving and forwarding media content across the telecommunication network which is inherent in all server/client environment and taught in Luzeski et al.’s reference in column 5, lines 46-55 and Figure 1, 12, server platform is shown to include applet server which provides format/capabilities based interfacing.

There’s no recitation or indication of a sever as part of the elements in Independent claims 1, and 11-13 to hint or indicate a tie-in or relationship/coupling between the database claimed in those claims and the server or to hint that these two have to communicate/share with each other directly. Or any recitation to what the server contains or stores.

In response to applicant argument to amended claim 8, and newly added claims 19-22, please see rejection above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See PTO Form-892 for list of Cited References.

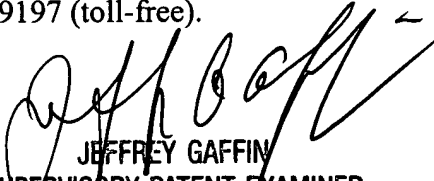
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
May 17, 2006



JEFFREY GAFFIN
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